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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,513	11/03/2000	John J. Gabrick	MINMAT.P03	6517

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EXAMINER


SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/706,513	Applicant(s) GABRICK ET AL.	
	Examiner Sandra Snapp	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed on 06-07-2004. Currently, claims 1-8 are pending in the application.

Drawings

The amended drawing submitted on 6-7-04 are objected to because the written information in some of the drawings is so small it is not legible. See Fig. 15c, graph in upper right corner.

Specification

The substitute specification has been entered into the application.

Claim Objections

The objections to claims 3 and 4 have been successfully overcome with the Amendment of 6-7-04.

Claim Rejections - 35 USC § 101

The amended claim language directed to a computer with a database has successfully overcome the previous rejection based on 35 U.S.C. 101, which is herein withdrawn.

Claim Rejections - 35 USC § 112

The rejection of claims 2, 5 and 6-8 as being indefinite is herein withdrawn in view of the amended language submitted on 6-7-04.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 3-8, drawn to a system for summarizes, searches and reports on company innovations, classified in class 705, subclass 36.
- II. Claim 2, drawn to a usage pattern of company secrets, classified in class 705, subclass 11.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention of Group I is directed to a system that summarizes, searches and reports on company innovations can be performed in clearly different and distinct ways than the usage pattern of company secrets that merely generates and displays a list of confidential material accessed and/or printed by an employee of a company.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Lerner patent (US 5,526,257) in view of the Tran et al. patent (US 6,157,935).

The Lerner reference discloses a system comprising at least one computer with at least one database of company innovation data resident thereon (Fig. 1),

wherein the system automatically summarizes company innovations (Abstract),

uses intelligent agents to automatically perform searches (col. 12, lines 37-46 – searching capabilities) on the Internet to find competing ideas (Network, col. 8, line 65 through col. 9, line 15), and

generates reports which list potential competitive strengths and weaknesses (Abstract) (Claim 1);

in a system within a company that provides access to an employee to company secrets, the employee thereby developing a usage pattern for the company secrets thus viewed, the improvement comprising:

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immediate display of the usage pattern for the employee (display, Abstract),
whereby the company can quickly generate and show the employee a listing of all
confidential materials accessed and/or printed by the employee (display, Abstract) (Claim 2);

a query engine to determine and report some or all of the ideas that an individual has
submitted over a selected time period (col. 13, lines 57-63) (Claim 3);

wherein employee performance, overall corporate innovation levels, and qualified and
motivated employees are measured and determined in accordance with the innovations entered
by employees into the system (measured and determined, Abstract) (Claim 4);

wherein an employee enters hours spent, along with other resources that contributed to
the innovation, so that IP assets can be assigned tangible values and tracked on the company's
balance sheet (input device, col. 10, lines 1-9) (Claim 5);

a system for streamlining the process of creating, preserving and/or protecting proprietary
assets, the system comprising at least one computer with at least one database of company
innovations data resident thereon, wherein the system identifies, classifies, compiles, tracks
and/or routes real-time innovation data automatically on a continuous basis (Abstract), and
provides instant access to the database of innovation information, taken from the group of
innovation information consisting of trade secret archives, patent filings, computed valuations,
and user information, further wherein an employee thereby has instant access to her latest
innovations and proprietary materials (display device - Abstract) (Claim 6);

adapted to an employee entering an intellectual creation taken from the group of
intellectual creations consisting of documents, ideas, schematics, and the like (input device – col.

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10, lines 1-9, and receiving an immediate, time/date certification therefor (Tran, e-mail – col. 10, lines 39-44) (Claim 7);

wherein the employee can link (network allows access to others, col. 8, line 65 through col. 9, line 15) more details on each submission, and other users can email comments and suggestions directly to the author, or optionally submit their own improvements as a new or supplemental innovation (Tran, e-mail - col. 8, lines 12-15) (Claim 8).

The Lerner patent lacks:

A system that is adapted to receiving an immediate, time/date certification therefor (Claim 7); and

A system wherein other users can email comments and suggestions directly to the author, or optionally submit their own improvements as a new or supplemental innovation (Claim 8).

The Tran patent teaches:

A system that is adapted to receiving an immediate, time/date certification therefor (Tran, e-mail – col. 10, lines 39-44) (Claim 7); and

A system wherein other users can email comments and suggestions directly to the author, or optionally submit their own improvements as a new or supplemental innovation (Tran, e-mail - col. 8, lines 12-15) (Claim 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Lerner system with the teachings of the Tran system so as to

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provide a system that records when information is recorded in the system, and provide users within the system the capability to communicate with others in the system.

With regard to the innovations and competing ideas (claim 1), company secrets and confidential materials (claim 2), ideas (claim 3), employee performance, innovation levels and qualified and motivated employees (claim 4), innovation and IP assets (claim 5), innovation information (claim 6), intellectual creations (claim 7), and improvements or supplemental innovation (claim 8), all of these are considered to be directed to the 'field of use' or are non-functional descriptive language that are not functionally related to the apparatus that is claimed. In other words, they are used to show the field of use of the apparatus or they are used to describe the type of information that is used in the system, but do not affect how the system itself works. As such, this information is not given patentable weight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Muiers et al., Halligan et al., McLean et al., Eder and Powell patents applications are all directed to various types of electronic data systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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